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APR 27 2007

OFFICE OF PETITIONS

In re Application of :
Martin et al. :
Application No.: 10/663503 : DECISION ON
Filing or 371(c) Date: 09/16/2003 : PETITION
Title of Invention: :
UPRIGHT STAND BIBLE/BOOK HOLDER :

This is a decision in response to the correspondence framed as a grievance report, filed May 9, 2006. The correspondence is properly treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed July 20, 2004. The Office action set a three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a).

Applicant filed a Reply in the form of an Amendment¹ on November 15, 2004; however, because the reply was filed after the three (3) month period set forth in the Office action, an extension of time was required. Applicant was so notified in an Office communication mailed August 9, 2005.

Applicant filed the extension of time fee on August 24, 2005.

Upon receipt of the extension of time fee, this Office reviewed the Reply/Amendment to the Office action and informed Applicant that the Amendment was non-compliant with Office rules.

¹ The Amendment was unexecuted.

A Notice of Non-Compliant Amendment was mailed on October 3, 2005. The Notice of Non-Compliant Amendment set a one (1) month period for reply. Extensions of time under 37 CFR 1.136(a) were available.

Applicant filed a second Amendment² on October 18, 2005.

The second Amendment was also non-compliant. Applicant was so notified in a second notice entitled "Failure to Acceptably Respond to Notice of Non-Compliant Amendment," mailed to Applicant on November 23, 2005. The second notice also informed Applicant that the period for reply continued to run from the mailing date of the prior Notice of Non-Compliant Amendment.

Applicant filed a third Amendment on December 6, 2005³, which was more than two months after the period for reply set forth in the October 3, 2005 Notice of Non-Compliant Amendment. As such, a two (2) month extension of time was required. Office records reveal that no extension of time request or fee for the belated filing of the third Amendment was submitted⁴.

The third Amendment also failed to acceptably respond to the October 3, 2005 Notice of Non-Compliant Amendment. Applicant was so notified in an Office communication mailed December 20, 2005. The Office communication also informed Applicants that a two (2) month extension of time was required, and that all Applicant's must sign their communications to the Office.

On January 23, 2006, Applicants filed a fourth (4) Amendment, without an extension of time request or fee.

The fourth Amendment was also non-compliant. Applicant was informed for the fourth time that the Amendment was not in compliance with Office rules, in a notice entitled "Failure to Acceptably Respond to Notice of Non-Compliant Amendment," mailed to Applicant on February 2, 2006. This notice also informed Applicant that the period for reply continued to run from the mailing date of the prior Notice of Non-Compliant Amendment (mailed October 3, 2005).

No timely and proper reply to the October 3, 2005 Notice having been received, the application became abandoned on November 4, 2005. A Notice of Abandonment was mailed August 31, 2006.

Petition under 37 CFR 1.181

Applicant files the present petition to the Director of Patents and includes the grievance report for four applications in the one document. In this application, Applicants contend that they have been informed that \$1080 is required to avoid abandonment of the application. Applicant further contends that a reply was filed January 17 and that Applicant has postal receipts to verify the mailing of the reply.

² The Amendment was unexecuted.

³ The Amendment was unexecuted.

⁴ Office records indicate that a telephone call was placed to Applicant (Ms. Martin), and a voice message was left

Analysis

1. Filing Separate Papers for Separate Applications

Applicant is advised, as an initial matter, that our rules require that separate matters be contained on separate papers. The rule states

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR 1.4(c)

Here, Applicant has included grievances for four applications in one document. Applicant is advised that separate matters be contained on separate papers.

2. Signing correspondence

Applicant is also advised that our rules require a signature on amendments. The rule, 37 CFR 1.33(b), states

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(4) All of the applicants for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

The Manual of Patent Examining Procedure (“MPEP”), instructs Office personnel that

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

When an unsigned or improperly signed amendment is received the amendment will be listed in the contents of the application file, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

In this instance, the Examiner nevertheless reviewed the Amendment for Applicant and informed Applicant that the Amendment was not in compliance with Office rules. Applicant is advised that this review was solely at the discretion of the Examiner. The rules and MPEP state

37 CFR 1.135(c) now authorizes the examiner to accept a reply to a non-final Office action that is *bona fide* and is substantially complete but for an inadvertent omission as an adequate reply to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135. When a bona fide attempt to reply includes an inadvertent omission that precludes action on the merits of the application (e.g., an amendment is unsigned or improperly signed, or presents an amendment with additional claims so as to require additional fees pursuant to 37 CFR 1.16(h), (i), or (j)), the examiner may consider that reply adequate to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135, and give the applicant a shortened statutory time period of 1 month to correct the omission (e.g., provide a duplicate paper or ratification, or submit the additional claims fees or cancel the claims so that no fee is due). The failure to timely supply the omission will result in abandonment under 35 U.S.C. 133 and 37 CFR 1.135. Extensions of time under 37 CFR 1.136(a) or (b) will be available, unless the action setting the shortened statutory period indicates otherwise.

MPEP 710.01

In other words, the Examiner saw that you were making an effort to file a proper reply, and opted to review the Amendment and provide Applicant with information on how to correct the Amendment, instead of holding the application abandoned, despite the fact that the reply was not properly (executed) signed.

Applicant is advised that it is the Applicant's responsibility to familiarize themselves with Office rules. When an Applicant attempts to prosecute an application without an attorney, the applicant places himself or herself in the shoes of an attorney and is tasked with the responsibility of knowing Office rules and complying with those rules.

3. Abandonment of the Application

This application is abandoned. Applicant was required to file a complete and proper reply to the Office action mailed back on July 20, 2004. Applicant is advised the an application goes abandoned according to statute and Office rules. The statute, 35 U.S.C. § 133, Time for prosecuting application, states

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

This section of the statute is further clarified in Office rule, 37 CFR § 1.135, Abandonment for failure to reply within time period, which states

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

This section explains that the reply must be both complete and proper as the condition of the application may require.

Here, Applicant repeatedly filed Amendments that were not in compliance with Office rules. Instead of holding the application abandoned, Applicant was given repeated opportunities to correct the deficiencies in the replies. Applicant failed to sign the Amendments, Applicant failed to timely reply to the Office communications, and Applicant failed to file the appropriate extension of time request and fees. Most importantly, Applicant failed to file a complete and proper reply because the Amendments failed to comply with 37 CFR 1.121.

Applicant is advised that, as provided in the Manual of Patent Examining Procedure,

[w]here an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

MPEP 711.03(c).

Here, there is no disagreement as to the sufficiency of the reply, or as to controlling dates. Applicant merely contends that a reply was timely filed. However, a complete and proper reply was not timely filed. As such, there is no dispute as to the status of the application. The application is abandoned. A petition to revive the application (and fee) is the appropriate course of action.

Alternate Venue

Applicant is urged to file a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned

application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$750.00 for a small entity⁵.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Finally, Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is further advised that there are two Offices: the Office of Independent Inventors, at 703-306-5568; and the Patent Assistance Center, at 1-800-786-9199, available to provide assistance in prosecuting patent applications.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods

Attorney
Office of Petitions

⁵ Applicant is further advised that a grantable petition under 37 CFR 1.137(b) requires, in addition to the petition and petition fee, the required reply, to wit, an acceptable appeal brief; a continuing application; a Request for Continued Examination ("RCE"), or a reply that places the application in condition for allowance.